

REMARKS

Claims 1-22 are pending in the application. Claim 1 is the sole independent claim. Dependent claims 2-7 have been amended to better present the invention to the Office, and to further prosecution of the subject application; no narrowing of the scope of the claimed subject matter is intended. Applicants respectfully request reconsideration of the application in light of the foregoing amendments and the following remarks.

The Claims Are Statutory Under § 101

The Office has rejected claims 2-7 as nonstatutory under 35 U.S.C. § 101 because they allegedly recite nonfunctional descriptive material. While Applicants respectfully disagree with the Office's contention, in an effort to expedite allowance Applicants have amended claims 2-7 to better present the invention to the Office. Specifically, as amended each of claims 2-7 recites functional matter that further defines the method set forth in independent claim 1. For example, claim 2 recites "... selecting an advertisement based upon a prior content request sent from said user node to an affiliate node." This requires that the act of selecting an advertisement must be based on a prior content request sent from said user node to an affiliate node, which is a functional limitation. Likewise, claims 3-7 also recite functional limitations.

Accordingly, for at least this reason, Applicants respectfully submit that claims 2-7 satisfy 35 U.S.C. § 101, and reconsideration and withdrawal of this rejection is therefore respectfully requested.

Claims 1-15, 19-22 Are Not Obvious

The Office has rejected claims 1-15 and 19-22 under 35 U.S.C. § 103 as being obvious over Wexler (U.S. Patent No. 5,960,409) in view of Goldhaber (U.S. Patent No. 5,794,210). Applicants respectfully traverse this rejection.

The invention defined by the present claims was reduced to actual practice prior to at least April 26, 1996. This date is established by the declarations under 37 C.F.R. §1.131 submitted by the named inventors of the present application in U.S. App. No. 10/254,923, and in U.S. Reissue App. No. 09/577,798, which is a reissue of U.S. Patent No. 5,948,061 (originally U.S. App. No. 08/738,634). The present application claims priority to both the '923 application

and the '634 application. Copies of these declarations are provided for the Examiner's convenience.¹

Wexler was filed on October 11, 1996, which occurred *after* the invention of the claimed subject matter by Applicants. Thus, Wexler is not prior art to the present application, and the rejection is therefore moot. Withdrawal of the rejection of claims 1-15, 19-22 is respectfully requested.

Claims 16-18 Are Not Obvious

The Office has rejected dependent claims 16-18 under 35 U.S.C. 103 as being obvious over Wexler and Goldhaber in further view of Funk (U.S. Patent No. 5,937,162). However, as explained above, Wexler is not prior art to the present application, and the rejection is therefore moot. Withdrawal of the rejection of claims 16-18 is respectfully requested.

¹ Applicants respectfully note that the establishment of conception and due diligence is not required for inventors swearing behind a date established by an actual reduction to practice.

CONCLUSION

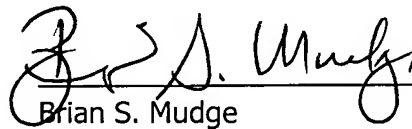
It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

The Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Office is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

Date: May 21, 2008

A handwritten signature in dark ink, appearing to read "Brian S. Mudge", is written over a horizontal line.

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